UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,393	06/18/2001	Manoel Tenorio	020431.0846	3582

53184	7590	01/13/2006

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EXAMINER
HAQ, NAEEM U

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/884,393	TENORIO, MANOEL
	Examiner	Art Unit
	Naeem Haq	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2005*.

2a)☒ This action is **FINAL**.　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Final Rejection

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borchers (US 2002/0147704 A1) in view of Chang et al. (US 5,089,985) and further in view of Breese et al. (US 6,006,218).

Referring to claims 1-25, Borchers teaches a system, method and software operable to: communicate a search query to a plurality of databases that contain data, each database operable to generate local search results responsive to the search query (page 1, paragraph [0008] – [0011]; page 2, paragraphs [0016] – [0021]). Borchers also teaches receiving the search results from the databases; merging the search results received from the databases to generate a merged search result (pages 2 and 3, paragraph [0021]); sorting the merged results according to a sorting parameter (page 2 and 3, paragraph [0021]). Borchers does not teach that the data is product data or that the database is a seller database. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system, method, or program. The steps of communicating receiving, merging, and sorting would be performed the same regardless of what information the database contained or what type of database was used. The differences between the Applicant's data/database table and the prior

art are merely subjective and do not patentably distinguish the claimed invention from the prior art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the database of Borchers because such information does not functionally relate to the elements of the claimed system, method, and program and because the subjective interpretation of information does not patentably distinguish the claimed invention. Borchers does not explicitly teach that his system is an electronic commerce system. However, the Examiner notes that this limitation appears only in the preamble of the claim. The preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present case, the body of the claim does not depend on the preamble for completeness and is able to stand alone because there is no commerce activity (i.e. transaction) taking place in the body of the claim. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the invention of Borchers in any environment. One of ordinary skill in the art would have been motivated to do so in order to meet the need of businesses and organizations to efficiently share information on a worldwide scale as taught by Borchers (paragraph [0004]). Borchers does not teach communicating one or more sorting parameters to the seller databases, the sorting parameters directing each seller

database to sort the search results generated at each database in response to the search query. However, Chang teaches a system and method for performing a sort operation in a relational database manager. Chang teaches that a database manager handles requests from users or programs (column 1, lines 14-17 and lines 26-32), and that SQL is a query language that allows users and programs to access data in a database through a database manager (column 1, lines 57-63; column 5, lines 51-63). Chang goes on to teach that one of the SQL operations a user or program can invoke is the "GROUP BY" operation (column 3, lines 52-55). Change teaches that the "GROUP BY" operation requires the relational database manager to perform a sort operation (column 7, lines 16-38; column 5, lines 40-43; Figure 1B, item "23"). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Chang into the invention of Borchers. One of ordinary skill in the art would have been motivated to do so in order to reduce the total sort time as taught by Chang (Abstract lines 16-19; column 2, lines 20-62). Borchers and Chang do not teach that the sorting parameter further directs the databases to initially communicate no more than a specified number of sorted search results in response to the search query. However, Breese teaches a method of retrieving information form a database wherein the number of search results is limited to fixed number (column 7, lines 18-58). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Breese into the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to protect the user from being overloaded with information.

Borchers, Chang, and Breese do not teach that the number of merged search results being less than or equal to the product of the specified number and the number of the seller databases to which the search query is communicated. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to limit the search result to any number desired. Applicant has not disclosed that limiting the search result to a number less than or equal to the product of the specified number and the number of the seller databases provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with any number of search results greater or equal to one because such a number does not affect or effect the system, method and program in anyway. Therefore, it would have been obvious to one of ordinary skill in this art to modify the teachings of Borchers to obtain the invention as specified in the claims. The cited prior art does not teach repeating the steps of claims for an additional search request. However, this is an inherent feature in the cited prior art because nothing in the prior art prevents the user from repeating the steps and because the prior art is designed to repeat the steps as many times as required by the user. Furthermore, good programming design would render obvious the need to repeat the steps of the cited prior art as many times as necessary. One of ordinary skill in the art would have been motivated to do so in order to make the most economical use of the cited prior art.

Response to Arguments

Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive. The Applicant has argued that Chang fails to teach the motivation cited by the Examiner in the previous Office Action, and that the Examiner has relied on improper hindsight in rejecting the Applicant's invention. The Applicant has also argued that the combination of the cited prior art is improper because Chang is not within Applicant's field of endeavor. The Examiner respectfully disagrees with these arguments. Chang provides the motivation for the combination by stating the following:

> *"The system and method of this invention reduces the total sort time by eliminating the overhead of writing the disk during the fast direct output mode. Also, the response time, or availability for each record is reduced since each record is retrieved or sent to the Relational Data Services immediately after it has been sorted into the final sort order instead of completing the entire sort first, and then writing to disk."* (Abstract)

Furthermore, Chang's invention is directed to a system and method for performing a sort operation in a database to pass the results to a user. Thus, Chang is within the Applicant's field of endeavor and/or reasonably pertinent to the Applicant's problem because the Applicant's invention performs a sort operation on a database and passes the results to a user. For these reasons, the Examiner maintains the art rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Naeem Haq whose telephone number is (571)-272-

6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Naeem Haq, Patent Examiner
Art Unit 3625

January 9, 2006